Appeal No. 2017-1100

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IN RE: C. DOUGLASS THOMAS,

Appellant

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Serial No. 12/878,199

BRIEF FOR DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

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35 U.S.C. 102..2

35 U.S.C. 102(e) 2

35 U.S.C. § 132..22

STATEMENT OF RELATED CASES

The Director is not aware of any other appeal in connection with this proceeding that has previously been before this or any other court, or any other case pending in this or any other court that will directly affect or directly be affected by the Court's decision in this appeal.

STATEMENT OF THE ISSUE

Claim 15 generally recites a method for generating customized documents over a network by operating an application program linked to a server to produce a processed file based on instructions from a "command set," which, according to the specification is a set of generic computer commands based on input received from the requester in response to prompts from the computer server. The Examiner rejected the claim as anticipated by Hoyt, which discloses a web-based applet with a graphical user interface (GUI) connected to a web server that gathers client input in response to multiple prompts and provides operations for editing text in a document template and based on the text entry produces a customized document that is then sent back to the client. The Board affirmed. The primary issue before this Court is whether substantial evidence supports the Board's conclusion that Hoyt's applet anticipates the rejected claim. Another issue raised by Thomas is whether the Board's construction of the claim term "word processing program" to encompass Hoyt's applet was reasonable.

As noted in section (D) of this brief, the Examiner finally rejected the claims pre-*Alice v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014). Presumably in view of the strength of the anticipation rejection, the Board did not analyze these claims as reciting abstract ideas under § 101. Although the issue is not presented in this appeal, the Director believes that the claimed methods are not patent-eligible based on *Alice* and its progeny.

STATEMENT OF THE CASE

This appeal arose from the examination of C. Douglass Thomas's U.S. Patent Application 12/878,199, titled "Method and System for Formation of Electronic Documents," filed on September 9, 2010, and claiming priority to a provisional application filed September 7, 1999. Appx20-65.[1] The Examiner rejected all pending claims[2] under 35 U.S.C. § 102(e) as anticipated by Hoyt. Appx95-102.[3] The Board affirmed. Appx1-7 (Bd. Dec.); Appx9-17 (Reh'g Dec.). Dependent claims 16-18 and 21-22 stand or fall with independent claim 15. Br. at 21. Thomas makes separate arguments as to one of the limitations common to both dependent claims 19 and 20. Br. at 22-26.

A. The Thomas Application: "Method and System for Formation of Electronic Documents"

The Thomas application is generally directed to creation of customized documents over a network. Appx22 (¶ [0007]). It describes using a server that executes document processing software to produce customized documents,

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1 "Appx___" refers to the joint appendix in this case; "Br. at ___" refers to Thomas's opening brief.

2 The pending claims are claims 15-22. In response to a restriction requirement, Thomas cancelled the non-elected claims 1-14. Appx75-76; Appx89-93.

3 U.S. Pat. No. 6,067,531 B2, filed June 21, 1998.

primarily legal documents, over a network. Appx34-35 (¶ [0051]). The server activates an "application program," such as "word processor, spreadsheet or database program," to assist the server computer in producing specified documents by following a command set based on user-provided answers to queries. Appx34-35 (¶¶ [0051]-[0052]).

The patent application illustrates "a document creation and delivery system 100" by block diagram (Fig. 1A, below). Appx26 (¶ [0031]).

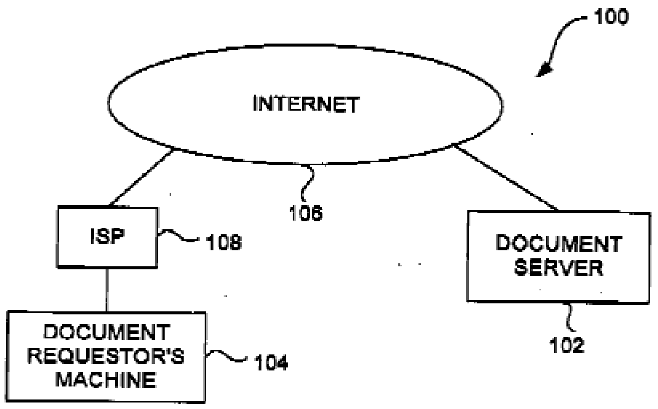


FIG. 1A

Appx52 (Fig. 1A).

The user's computer (i.e., "the document requestor's machine 104") connects to the Internet through an Internet Service Provider 108. Appx26 (¶ [0031]). The document server 102 operates "to question or interrogate the requestor" through the Internet, and obtain the requisite information to produce the specified document. Appx26 (¶ [0031]). The document server then forwards the customized document that has been created to the user through the Internet.

Appx26-27 (¶ [0031]).

Fig. 2 depicts a flowchart illustrating the steps of producing a customized legal document in accordance with one embodiment. Appx27-28 (¶¶ [0033]-[0035]).

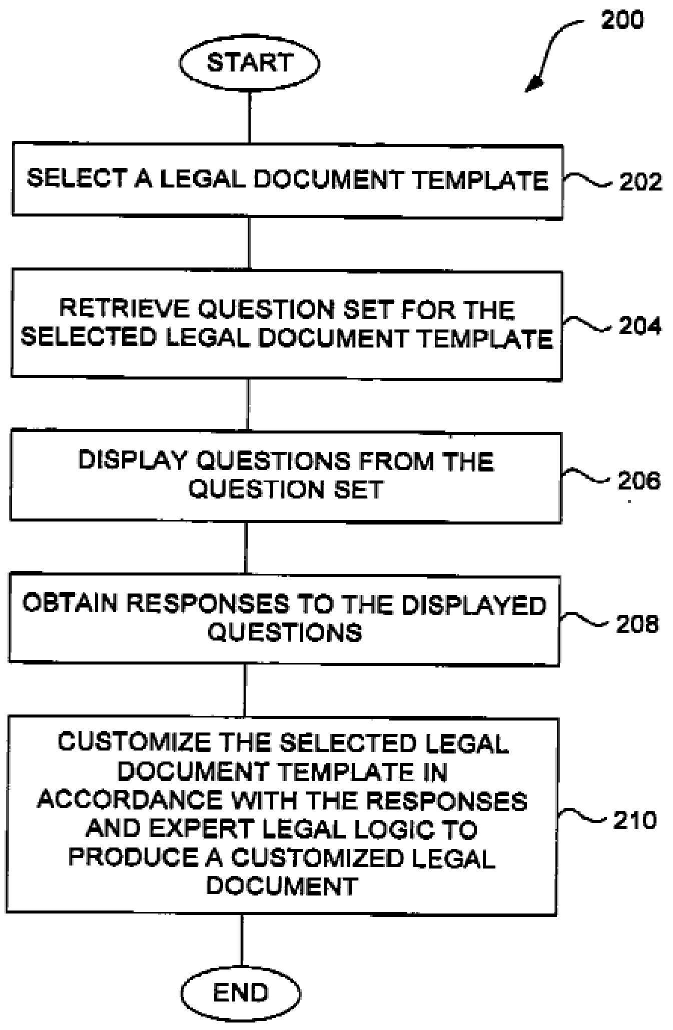

200
START
SELECT A LEGAL DOCUMENT TEMPLATE
202
RETRIEVE QUESTION SET FOR THE SELECTED LEGAL DOCUMENT TEMPLATE
204
DISPLAY QUESTIONS FROM THE QUESTION SET
206
OBTAIN RESPONSES TO THE DISPLAYED QUESTIONS
208
CUSTOMIZE THE SELECTED LEGAL DOCUMENT TEMPLATE IN ACCORDANCE WITH THE RESPONSES AND EXPERT LEGAL LOGIC TO PRODUCE A CUSTOMIZED LEGAL DOCUMENT
210
END

FIG. 2

Appx53 (Fig. 2).

In this embodiment, a document processing program 200 receives an initial request 202 from a user for a type of legal document. Appx28 (¶ [0034]). Based on the type of legal document selected, a question set is retrieved from a storage location on the document server 204. *Id.*; Appx27(¶ [0032]). The question set is displayed to the user 206 and the user then reads and responds to these questions 208. Appx28 (¶ [0034]). Based on the responses, the document processing program 200 uses a macro or executable program to produce a customized legal document 210. *Id.*; Appx34 (¶ [0051]); *see also* Appx65 (Fig. 12). The customized legal document is then sent to the user. Appx28 (¶ [0034])

The macro used by the document processing program is specified as "expert legal logic" in the embodiment above. Appx28 (¶ [0035]). Expert legal logic is defined as a predetermined set of rules that replicates expert knowledge to make automated legal decisions about content to be placed in the customized document. Appx28 (¶ [0035]). The expert legal logic controls the content and verbiage of the document being produced. Appx30 (¶ [0038]).

Claim 15 recites a four-step method with two "wherein" clauses:

> 15. A method for enhancing functionality of a server computing device coupled to a network, said method comprising:
>
> operating the server computing device to receive a request for a file from a requestor;
>
> linking an application program to the server computing device;

> operating the application program in accordance with a command set to produce a processed file; and
>
> returning the processed file to the requestor,
>
> wherein the application program is a word processing program, and wherein the command set is a macro or a program executable by the word processing program.

Appx126. Claims 19 and 20 both directly or indirectly depend from claim 15, and further recite "wherein the request includes the command set or information used to produce the command set." Appx127.

The specification provides no further direction, algorithm, or any structure (beyond a programmed general purpose computer) corresponding to the above functional claim limitations.

B. Prior Art

1. Hoyt: Automatic Contract Creation

Hoyt discloses a system and method for server-side automated contract generation among multiple clients within a business organization, coupled by a network, accessing a contract database server. Appx208 (col.1, ll.65-67); Appx209 (col.4, ll.53-64).

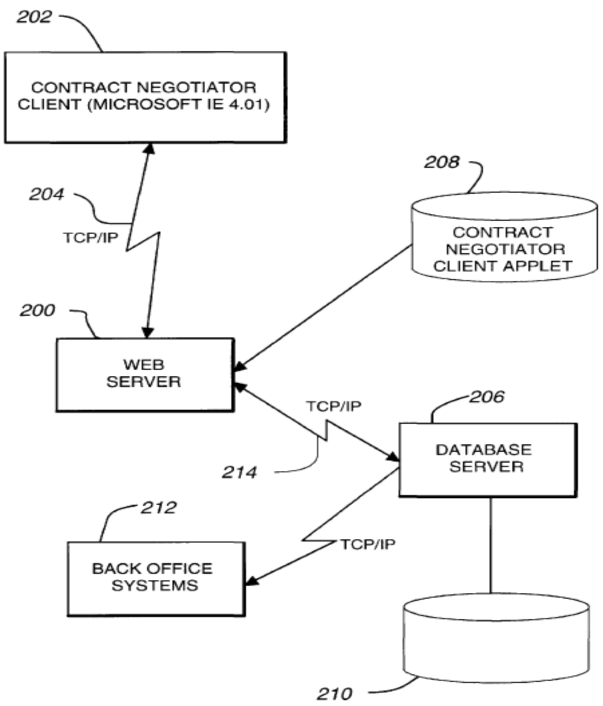
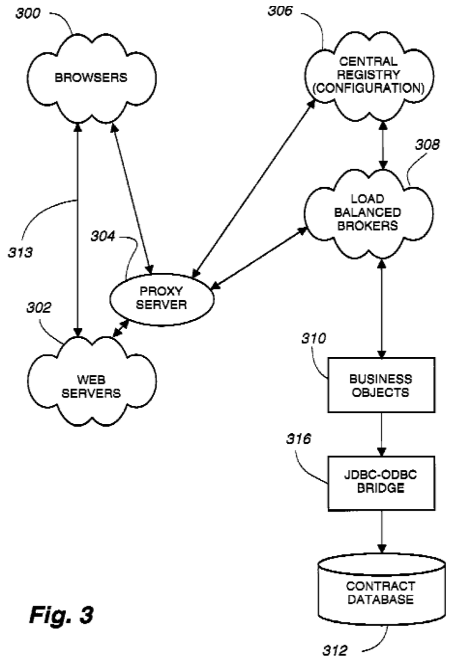

202
CONTRACT NEGOTIATOR
CLIENT (MICROSOFT IE 4.01)
204
TCP/IP
208
CONTRACT
NEGOTIATOR
CLIENT APPLET
200
WEB
SERVER
TCP/IP
206
DATABASE
SERVER
214
212
BACK OFFICE
SYSTEMS
TCP/IP
210

Fig. 2

At a high-level, as illustrated in Fig. 2 (Appx185) above, Hoyt's logical architecture consists of a "zero-footprint" web-based application that does not require the frontend client 202 to install any software and runs entirely embedded within an existing browser, such as Microsoft Internet Explorer, by a backend web server 200. Appx209 (col.4, ll.14-37). When a client accesses the web server 200 through a web browser, the Contract Negotiator Client Applet 208 is accessed by the web server 200 and deployed onto the client computer 202, which then executes the applet. *Id.* The applet provides the graphical user interface (GUI) for automatic contract generation and enables communication between the client 202 and the web server 200 over a network 204 to generate a customized contract. *Id.*;

Appx208 (col.2, ll.28-37); Appx186 (Fig. 3).

Hoyt's client-server architecture is illustrated in more detail in Fig. 3 below:


300
BROWSERS
306
CENTRAL
REGISTRY
(CONFIGURATION)
308
LOAD
BALANCED
BROKERS
313
304
PROXY
SERVER
302
WEB
SERVERS
310
BUSINESS
OBJECTS
316
JDBC-ODBC
BRIDGE
CONTRACT
DATABASE
312
Fig. 3

A186. In operation, the client system uses a web browser 300, such as Internet Explorer, which executes one or more client applets. Appx210 (col.5, ll.21-39). The web server 302 distributes the most current contract negotiator applet code to the client system through the Internet or a network 313. *Id.* The applet consists of a GUI component, which enables communication between the user and the web server via the browser. *Id.* As a preferred embodiment, "a 'webRoaster' component is combined with a contract negotiator JAVA applet embodying the GUI and communication functionalities of the contract negotiator." *Id.* The webRoaster applet provides the client applet GUI in a separate browser frame on the client system 300 and connects to the proxy server 304. Appx210 (col.6, ll.5-14). Proxy server 304 runs on the same physical machine as web server 302 and is used by the webRoaster to provide access to the underlying database server 312. Appx210 (col.5, ll.40-45).

As such, the pop-up box 1600 of Fig. 16 (depicted below), is a feature of a GUI of the contract negotiator applet and is presented in a separate browser frame through the webRoaster. Appx224 (col.34, ll.1-23).

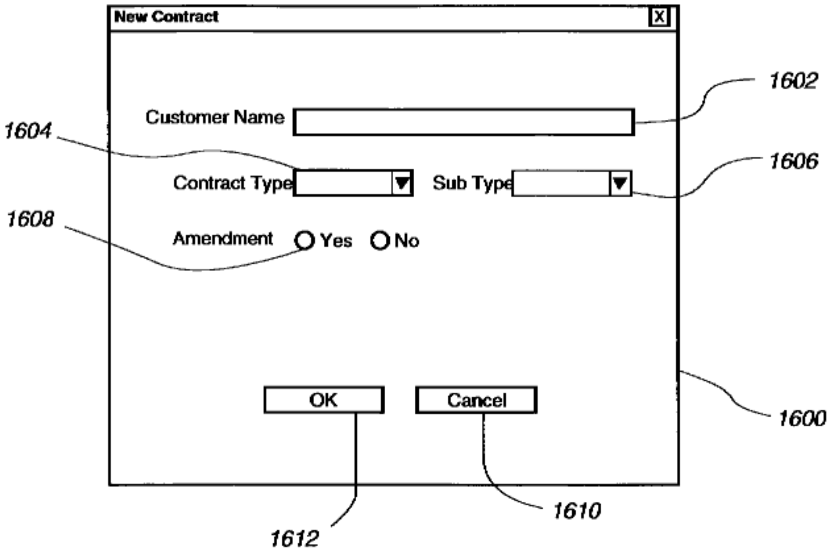

New Contract
X
1602
Customer Name
1604
1606
Contract Type
Sub Type
1608
Amendment
Yes
No
OK
Cancel
1600
1610
1612

Fig. 16

As depicted in Fig. 16 of Hoyt (Appx203), when the user initiates a new contract, a pop-up box (1600, above) is displayed as part of the GUI. Appx224 (col.34, ll.1-7). The pop-up box 1600 prompts the user to enter in contract terms such as customer name 1602, utilize drop-down menus for contract type 1604 and contract subtype 1606, and selects from radio buttons 1608 to indicate whether the current contract is an amendment to an existing contract. *Id.* Upon pressing the

"OK" radio button (1612), the user-typed text is processed and a new contract is initiated. Appx224 (col.33, ll. 15-20). Upon initiation of the new contract, the user may begin entering further text, namely "terms and comments into the contract tree of the new contract." *Id*. The pop up box of the applet also contains a "cancel" radio button (1610), which is programmed to allow a user to "abort the initiation of a new contract." *Id.*

C. The Board's Decisions Affirming the Anticipation Rejection

The Board affirmed the Examiner's rejection of claims 15-22 as anticipated by Hoyt. Appx2-7. On Thomas's request for rehearing, the Board maintained its anticipation rejection of Thomas's claims. Appx9-17.

First, the Board affirmed the Examiner's finding that Hoyt discloses all the limitations of claim 15. Appx4-6 (citing Final Office action at 3-4, Appx97-98; Examiner's Answer at 7-9, Appx137-139); Appx14 (Reh'g Dec.). With respect to the preamble language "enhancing functionality of a server computing device coupled to a network," the Board found that it need not decide whether that language is a substantive limitation based on the Examiner's determination that Hoyt's system did, in fact, enhance the functionality of a server coupled to a network. Appx4-5 (citing Appx137-138); *see also* Appx97 (citing Abstract, at Appx183); Appx137-138 (citing Abstract, at Appx183; Hoyt col.2, ll.28-37, at Appx208).

The Board further found that the Examiner provided a full explanation as to how Hoyt discloses all of the steps recited in method claim 15. Appx4-5; Appx11-13. The Examiner found that Hoyt's GUI's pop-up box – which is displayed to the user when "a request [is] made to the server to create a new contract" – necessarily describes "operating the server computing device to receive a request for a file from a requestor." Appx97; Appx134. Next, the Examiner found that Hoyt's transfer of information entered into the pop-up box to the server for processing and initiation of a contract tree teaches "linking an application program to the web server computing device." Appx97; Appx134. In other words, since there is clearly a network connection between the contract negotiator applet (an application program that includes the GUI's pop up box) and the server, the element of "linking an application program to the server computing device" is satisfied. Appx13-14. On rehearing, the Board further noted that the Examiner "specifically found server functionality" in Hoyt's disclosure of these two limitations. *Id.*

The Board also agreed with the Examiner that Hoyt's disclosure of a user inputting information "according to the rules of the pop-up box" – text for customer name 1602, choosing radio buttons to determine whether the contract is an amendment of an old contract 1608, or selecting items from a drop-down menu for contract type 1604 and subtype 1608 – in order to "initiate a new contract" is "equivalent" to "operating the application program in accordance with a command set to produce a processed file." Appx97; Appx134-35. Finally, the Board further agreed that Hoyt's "displaying a contract tree according to the user input" discloses "returning the processed file to the requestor." *Id.*

In addition, the Examiner found Hoyt also disclosed the limitations of the two wherein clauses. Appx98; Appx134-35. The first wherein clause limits the application program to a "word processing program," but does not define any particular method. Accordingly, giving the term "word processing program" the broadest reasonable interpretation in light of the specification, the Examiner found that Hoyt's applet reads upon "a word processing program" because it is programmed to allow a user to enter text into the pop-up box of the applet's GUI that is then processed and used to initiate a contract tree for the user to enter even more text for incorporation into the newly processed legal document. Appx14 (citing Appx98). As to the second wherein clause, which limits the "command set" to a "macro or a program executable by the word processing program," the Examiner explained that the pop up box's radio buttons – which when clicked perform a set of instructions that operate to amend an existing contract or to cancel the creation of the contract – meet the macro command limitation. *Id.* Like a macro, each button is tied to processes that are performed upon user selection of the button. *Id.*

As to the "wherein the request includes the command set or information used to produce the command set" limitation in claims 19 and 20, the Examiner found that limitation met by Hoyt's display of the pop-up box in response to a user's request for creation of a new contract. Appx6-7 (citing Appx99; Appx139-140). As the Examiner previously explained, the pop up box of the applet itself includes a command set. Appx97; Appx134-135.

Finding that Thomas had failed to rebut the Examiner's strong *prima facie* case of anticipation as to all the pending claims, the Board sustained the Examiner's rejections. Appx4-6.

SUMMARY OF THE ARGUMENT

There is little room for debate that all the steps of method claim 15 – (1) operating the server computing device to receive a request for a file from a requestor; (2) linking an application program to the server computing device; (3) operating the application program in accordance with a command set to produce a processed file . . . wherein the application program is a word processing program, and wherein the command set is a macro or a program executable by the word processing program; and (4) returning the processed file to the requestor – are taught by Hoyt. Thomas's attempt to distinguish Hoyt based on the argument that Hoyt's disclosure is limited to a "pop-up box," and a "pop-up box" is not an application program let alone a word processing program falls short, because

Hoyt's pop-up box (which is part of the server-side applet) plainly provides for creating, editing, and storing text in a document template – *i.e.* "word processing," by any definition.

Thomas's challenge to the rejection of dependent claims 19 and 20 (which additionally recite "wherein the request includes the command set or information used to produce the command set") also fails. As the Examiner found, Hoyt plainly teaches that the request includes "information used to produce the command set" because the request prompts the server to display the pop-up box (which includes radio buttons that embody command sets). Contrary to Thomas's characterization (Br. at 23-26), the Examiner was not presenting a "tardy justification" when the Examiner further explained in his Answer that the radio buttons in Hoyt's pop-up box also include a command set. The Examiner was merely applying to claim 19 what he had already found with respect to claim 15's limitation "operating the application program in accordance with a command set."

Thomas's procedural arguments likewise fail to demonstrate error in the anticipation rejection.

Finally, the Director notes that Thomas's claims are directed to an "abstract idea" and thus do not qualify as patent-eligible subject matter under *Alice* and its progeny. Although neither the Board nor the Examiner reached this issue (because the Examiner's Final Office action was issued before *Alice*, and the Board merely reviewed the anticipation rejection), this Court could affirm on this alternative ground. *In re Comiskey*, 554 F.3d 967, 969 (Fed. Cir. 2009).

ARGUMENT

A. Standard of Review

Thomas has the burden to show that the Board committed reversible error. *In re Watts*, 354 F.3d 1362, 1369 (Fed. Cir. 2004); *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011). "During examination, claims . . . are to be given their broadest reasonable interpretation consistent with the specification." *In re Montgomery*, 677 F.3d 1375, 1379 (Fed. Cir. 2012) (quotation omitted). This Court reviews that construction to determine whether it is reasonable in light of all the evidence before the Board. *See, e.g., In re Etter*, 756 F.2d 852, 858 (Fed. Cir. 1985) (en banc); *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997).

Anticipation is a question of fact. *In re Gleave*, 560 F.3d 1331, 1334-35 (Fed. Cir. 2009). What the prior art discloses is also a factual inquiry. *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1088 (Fed. Cir. 1995). This Court reviews Board factual findings for substantial evidence. *Gleave,* 560 F.3d at 1335. Substantial evidence "is something less than the weight of the evidence but more than a mere scintilla of evidence," *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000), and "means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion," *Consol. Edison Co. v. Nat'l Labor Relations*

Bd., 305 U.S. 197, 229 (1938). "If the evidence in record will support several reasonable but contradictory conclusions," this Court "will not find the Board's decision unsupported by substantial evidence simply because the Board chose one conclusion over another plausible alternative." *In re Jolley*, 308 F.3d 1317, 1320 (Fed. Cir. 2002).

B. Substantial Evidence Supports the Board's Conclusion That All Pending Claims Are Anticipated by Hoyt

1. Hoyt teaches each and every limitation of independent claim 15

The Examiner and the Board established that independent claim 15 is anticipated by Hoyt. Appx4-6 (citing Final Office action, Appx97-98; Examiner's Answer, Appx137-139); Appx11-14 (citing Final Office action, Appx97-98). Hoyt teaches all the steps claimed in Thomas's method claim 15. The following table identifies where Hoyt discloses the various steps recited in claim 15:

Claim 15 limitation (A126)	**Hoyt's Disclosure:**
operating the server computing device to receive a request for a file from a requestor;	describes GUI's pop-up box which is displayed to the user by the server when the user of the contract negotiator applet makes a request *to the server* to create a new contract (Appx224 (col.34, ll.2-5); Appx185 (Fig.2); Appx186 (Fig.3); Appx203 (Fig.16))

linking an application program to the server computing device;	illustrates and describes a network connection between the contract negotiator applet (an application program that includes the GUI's pop-up box) and the server when information entered into the popup box is transferred *to the server* so as to initiate the new contract according to the input (Appx224 (col.34, ll.5-20); Appx185 (Fig.2 (204); Appx186 (Fig.3 (313); Appx203 (Fig.16))
operating the application program in accordance with a command set to produce a processed file; and	illustrates and describes a user inputting information according to the rules of the pop-up box 1600 [(Appx203 (Fig.16))] prompts– text for customer name 1602, choosing radio buttons to determine whether the contract is an amendment of an old contract 1608, or selecting items from a drop-down menu for contract type 1604 and subtype 1608 – in order to initiate a new contract according to the input prompts of the pop-up box (Appx224 (col.34, ll.4-20))
returning the processed file to the requestor,	describes initiating the new contract template according to the user input and then displaying a contract tree to the user to enter additional "terms and comments" for the new contract (Appx224 (col.34, ll.17-23))
wherein the application program is a word processing program, and wherein the command set is a macro or a program executable by the word processing program.	describes the pop-up box of the GUI window which is programmed to allow words to be populated by the user in the pop-up box fields, such as customer name 1602, which is then processed and used to initiate a contract tree for the user to enter even more text ("terms and comments") for incorporation into the newly processed contract template (Appx224 (col.34, ll.17-23)); also describing radio buttons displayed in Hoyt's pop-up box of the GUI window, perform as a macro, *i.e.*, when selected, they perform a set of functions that operate to amend an existing stored contract [(1608 (Fig. 16))], cancel creation of the contract [(1610 (Fig. 16))], or initiate the creation of a new contract template [(1612 (Fig. 16))]

On appeal, Thomas's argument centers around his contention that Hoyt's pop-up box is neither an "application program" (*see, e.g.*, Br. at 14) nor a "word processing program" (Br. at 15), which Thomas (citing two dictionary definitions) defines as a program used to create, edit and store documents (Br. at 17-18). Based on this understanding, Thomas also contends that the pop-up box is not producing a processed file, and thus does not teach operating an application program in accordance with a command set. Br. at 19-20.

However, as Board and Examiner found, the program running the pop-up box plainly qualifies as a "word processing program" because the pop-up box "is configured to allow words to be entered by the user . . . which is the same as a word processing program.'" Appx14 (quoting Final Office action at 4, Appx98 (citing Hoyt, col. 34, lines 1-23 and Figs. 2, 3 & 16 (Appx224, Appx185, Appx186, Appx203, respectively)). The Board had no occasion to address Thomas's "create, edit, and store" definition of word processing program, because Thomas did not present it to the Board. Arguments based on this belatedly proffered definition are thus waived. In any event, Hoyt's pop-up box clearly allows a user to enter and edit text, and based on that text entry, Hoyt's program creates a new legal document, which must be stored somewhere considering it discloses amending existing contracts. *See* Appx209 (col.4, ll.55-60) (pointing to storage medium 210 in Figure 2 in disclosing "[c]ontract and user data used by the contract negotiator application is stored on storage medium 210 and serviced by database server 206”).

More to the point, Thomas’s specification depicts and describes question and answer sets of its “word processing application” which produces a customized document from a template. *See, e.g.*, Appx36-37 (¶¶ [0051]-[0052]); Appx65 (Fig. 12); Appx27 (¶[0027]) (“The expert logic 160 is provided and predetermined so that the document server 150 is able to automatically customize a particular document template in accordance with the answers to the particular question set.”). This is exactly what Hoyt does, so it stands to reason that Hoyt involves a “word processing application” as well. Further, as the Board and Examiner found, the Hoyt reference, taken as a whole, teaches that the pop-up box is part of a web-based application connected to a web server, which provides the GUI to the user. Hoyt’s overall application therefore clearly reads upon both the claimed “application program” and the claimed “word processing program.” Appx137-139, Appx11, Appx16.

Thomas’s argument as to the “command set” limitation appears to be based on his argument that the pop-up box is not a word processing program. Br. at 19-21. That argument is addressed immediately above. Assuming the Court agrees that the application running the pop-up box includes word processing functionality, any interaction with the pop-up box according to the rules of the pop-up box (*e.g.*, specifying that the document is to be a new sales contract as opposed to an amendment to an existing sales contract) likewise results in a series of commands being carried out, thereby meeting the limitation of operating in accordance with a command set. Appx14; Appx 97. As to the wherein-clause limitation specifying that the command set is a macro, this is met by the radio buttons, which carry out a series of commands when selected, and thus necessarily embody macros. Appx13-14.[4]

2. Hoyt further discloses the additional limitation of dependent claims 19-20

Dependent claims 19 and 20 add the limitation "wherein the request includes the command set or information used to produce the command set." Appx127. As the Examiner and the Board found, because a user request in Hoyt results in the display of a pop-up box, and the rules of the pop-up box – including its fields and radio buttons – can fairly be viewed as a command set, that means that the user's request must have included information that was used to produce a command set.

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[4] Appellant also appears to contend that a cancel button is the opposite of a macro. Br. at 20. However, as the Board and Examiner found, cancellation is a command that involves a set of instructions being invoked by user selection, and as such qualifies as a macro. Appx14 (citing Final Office Action at 4, Appx98). Additionally, it should be noted that selecting to amend an existing contract, and clicking the "OK" radio button, undoubtedly produces a processed file.

Appx6 (citing Final Office action, at Appx99; Examiner's Answer, at Appx139-140).

Contrary to Thomas's characterization (Br. at 23-26), the Examiner was not tardy in setting forth this rejection. The final office action stated that "Hoyt discusses the request for a new contract to be created prompting the pop-up box to be displayed to the user." Appx99. In the "Response to Argument" section in his Answer, the Examiner merely elaborated that the pop-up box contained buttons such as "cancel" and "ok," the selection which resulted in a command set being executed (as the Examiner had already found in connection with claim 15). Again, because the pop-up box appeared in response to the user's request, this means that the request contained information to produce the command set.

C. The Board Properly Considered Thomas's Appeal Arguments

In its decision, the Board observed repeatedly that Thomas's arguments were conclusory and failed to overcome the Examiner's prima facie case. Appx2-7. On appeal, Thomas argues that the Board committed legal error by improperly burdening him with specific rebuttal requirements, arguing that the Board was required to perform a de novo review of the Examiner's rejections. Br. at 7-10. This is not correct. *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) ("[I]t has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections.") (citing *Ex parte Frye*, 2010 WL 889747) (B.P.A.I 2010)).

The act of filing a Board appeal did not entitle Thomas to de novo review of "all aspects" of the rejection. *See Frye*, 2010 WL 889747, at *4.

The appeal in *Jung* was also advanced by a party who, like Thomas, primarily argued a procedural flaw in the USPTO's examination, as opposed to the actual merits of the anticipation rejection. In response, this Court affirmed the Board, explaining that the USPTO fulfills its initial burden of setting forth a prima facie case by "adequately explaining the shortcomings it perceives so that the applicant is properly notified and able to respond." *Jung*, 637 F.3d at 1362 (quoting *Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007)) (quotes and brackets omitted). That standard is rooted in the statute, which requires the examiner to sufficiently explain the reasons for the rejection so that the applicant can judge the propriety of moving forward with prosecution. 35 U.S.C. § 132.

Here, the Examiner more than satisfied that basic requirement when he gave notice of his anticipation rejection based on Hoyt. Appx97-98. Specifically, the Examiner went through the claim limitations and compared them to Hoyt. The Examiner looked at Figures 2, 3, and 16 in Hoyt and the description of the pop-up box of the GUI at column 34, lines 1-23, and explained that those portions of Hoyt, taken as a whole, teach each and every limitation of the claims. Appx97-99. The Examiner thus made out a prima facie case of anticipation. The Examiner was required to do no more. At that point, the burden shifted to Thomas to rebut the prima facie showing.

On appeal to the Board, Thomas pressed the preamble language (Appx121) (which Thomas no longer argues on appeal to this Court), and argued that his claims are "unrelated to a pop-up box" (Appx119-122) and the Board correctly rejected both arguments. Specifically, the Board found (i) that the Examiner correctly found that to the extent the preamble was a limitation, it was disclosed by the prior art (Appx4-5), and (ii) the broad claim language is (Thomas's argument notwithstanding) met by the Hoyt's pop-up box (*id.*). Although the Board was not required to address Thomas's conclusory arguments to the effect that his claim limitations were not in the prior art, it nevertheless did so anyway in the rehearing decision. Appx11-17. Given that the Board agreed with the Examiner's rejections, and Thomas has not provided any sound basis for overcoming those rejections, Thomas's procedural arguments have no merit.

D. Although the Board Had No Occasion To Address the Issue, Thomas's Claims Are Directed to a Patent-Ineligible Abstract Idea Under 35 U.S.C. § 101

Although neither the Examiner nor the Board rejected Thomas's claims under 35 U.S.C. § 101, the Director notes that these claims would likely fail to qualify as patent-eligible subject matter under case law that has developed after the close of examination in this case. *Alice*, 134 S. Ct. 2347 (2014); *Electric Power*

Group, LLC v. Alstom S.A., 830 F.3d 1350 (Fed. Cir. 2016). In particular, Thomas's claims merely recite the abstract concepts of enhancing functionality of a server over a network using routine and conventional steps specified at a high-level of generality reciting providing an input to a server processor and performing a set of commands on that input to provide an output using a generic server-side computer with access to a database in the particular technological environment of a computer-implemented network, "without more." *Electric Power Group*, 830 F.3d at 1354. Given that the recited functions are not claimed as "technical means for performing the functions that are arguably an advance over conventional computer and network technology," *id.* at 1351, the recited functions here do "nothing significant to differentiate a process from ordinary mental processes," *id.* at 1355.

The claims here are unlike the claims in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016), that were found patent eligible, and far more like the claims in *Electric Power Group* that were found ineligible. As this court explained in *Electric Power Group, Enfish*

> relied on the distinction made in *Alice* between, on one hand, computer-functionality improvements, and, on the other, uses of existing computers as tools in aid of processes focused on "abstract ideas" (in *Alice*, as in so many other § 101 cases, the abstract ideas being the creation and manipulation of legal obligations such as contracts involved in fundamental economic practices).

Electric Power Group, 830 F.3d at 1354. Just as in *Electric Power Group,* these claims focus not on improvements in computers as tools, but on certain independently abstract ideas that use computers as tools. *Id.* This Court can affirm the Board's decision on the alternative ground that the claimed invention is outside the scope of 35 U.S.C. §101. *In re Comiskey*, 554 F.3d 967, 969, 981 (Fed. Cir. 2009) (choosing not to reach Board's obviousness rejection on the basis that claims were ineligible under section 101).

CONCLUSION

For the foregoing reasons, the Board's decision should be affirmed.

Respectfully submitted,

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May 4, 2017

CERTIFICATE OF SERVICE

I hereby certify that, on May 4, 2017, I electronically filed the foregoing BRIEF FOR DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE using the Court's CM/ECF filing system. Counsel for Appellant was electronically served through the Court's CM/ECF filing system per Fed. R. App. P. 25 and Fed. Cir. R. 25(a) and 25(b).

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